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PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: A8506

BELKNAP, William R., et al.

Appln. No.: 09/986,248

Group Art Unit: 2173

Confirmation No.: 5036

Examiner: Dennis G. Bonshock

Filed: November 8, 2001

For: **SYSTEM AND METHOD FOR PACKING OF SMALL
OBJECTS FOR EFFICIENT DELIVERY OVER NETWORKS**

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits this Reply Brief in response to the Examiner's Answer dated January 17, 2006. Entry of this Reply Brief is respectfully requested.

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STATUS OF CLAIMS

Claims 1-10, 13-23, 25-29 and 31-32 are all the claims pending in the present application and of these claims, claims 1, 8, 13, 20, 25, 28 and 31 are independent claims.

Claims 1-10, 13-23, 25-29, and 31-32 stand rejected on the following grounds:

- Claims 1-3, 13-15 and 25-26 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,282,711 to Halpern (“Halpern”).
- Claims 4-5 and 16-17 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Halpern.
- Claims 6-10, 18-23, 27-29 and 31-32 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Halpern in view of U.S. Patent No. 6,075,943 to Feinman (“Feinman”).

The rejection of each of these pending claims is being appealed.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following is a concise statement of each ground of rejection presented for review:

1. Whether claims 1-3, 13-15 and 25-26 are properly rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Halpern.
2. Whether claims 4-5 and 16-17 are properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Halpern.
3. Whether claims 6-10, 18-23, 27-29 and 31-32 are properly rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Halpern in view of Feinman.

ARGUMENT

Appellant submits the following in response to the Examiner's Answer and specifically to the Examiner's comments that begin on page 14 of the Examiner's Answer.

1. Claims 1-3, 13-15 and 25-26

Claims 1-3, 13-15 and 25-26 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Halpern. Among these claims, claims 1, 13 and 25 are independent claims.

Claim 1:

The Examiner now, for the first time in the Examiner's Answer, asserts that “[t]he ‘self-extracting executable’ of Halpern is a file that contains one or more compressed text or data files that when run, un-compresses (unpacks) the compressed (packed) files...” See Ex. Ans. at p. 18. In stating that “[t]his ‘self-extracting executable’ relieves the user from manually pull[ing] objects from the compressed file,” the Examiner attempts to distinguish the user's actions in executing the received setup.exe or install.exe files from decompressing the applications sent to a client. See *Id.* (“This ‘automatically unpacking’ is a process of decompressing objects automatically, without user interaction.”)

First, the Examiner improperly equates “unpacking” with “decompressing” in contrast to the intrinsic evidence. The present application clearly uses these terms to describe different actions. See, for example, claim 2 which recites, “further comprising decompressing the plurality of unpacked objects.” The Federal Circuit, in *Phillips v. AWH Corp.*, 75 USPQ2d 1321, 1327 (Fed. Cir. 2005), recently stated that “[d]ifferences among claims can also be a useful

guide in understanding the meaning of particular claim terms.” Instead of looking to intrinsic evidence, such as the claims and specification, to interpret the meaning of “unpack” the Examiner improperly jumps to extrinsic evidence relying only on dictionary definitions to support his interpretation of the claims. As the Federal Circuit stated in *Phillips*, “[t]he main problem with elevating the dictionary to such prominence is that it focuses the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent. Properly viewed, the ‘ordinary meaning’ of a claim term is its meaning to the ordinary artisan after reading the entire patent.” *Id.* at 1332. Simply looking at the claims reveals that the Examiner improperly equates “unpacking” with “decompressing” and runs afoul of the Federal Circuit’s guidance in interpreting a claim term. Accordingly, the Examiner’s reliance on Halpern’s discussion of “decompressing” to teach “unpacking” is misplaced.

Second, the Examiner relies on his improper interpretation of “automatically unpacking the plurality of objects contained in the response message,” by equating “unpacking” with “decompressing” in an unreasonable attempt to divorce the user’s role in extracting files from the decompressing operation. Halpern, states that a user executes the received setup.exe or install.exe files to install the application. See col. 6, lines 49-50. If installing files received from the server is deemed to “unpack” those files, then a necessary step in installing those files is to execute the extraction operation. The Examiner’s attempt to isolate that part of the installation process is unreasonable because without the user executing the setup.exe or install.exe file the extraction does not occur and the application programs will not be installed. Accordingly, the

Board should resist the Examiner's urging to ignore the user's role in extracting files received from the server.

Third, the Examiner now contends for the first time that a portion of Halpern relating to a "batch-mode" operation (col. 6, lines 29-35) anticipates claim 1. However, this portion of Halpern does not teach all the limitations of claim 1. Claim 1 requires "requesting a plurality of objects from the server." Claim 1 also requires "receiving a response message from the server, the response message containing the plurality of objects packed into the response message." In other words, claim 1 requires requesting the very same objects that are received in the response message. Halpern does not teach this feature. Instead, Halpern discloses a user interface from which the "user then chooses all software components and options that he desires his software package to have." Col. 3, lines 37-38. An "installation set generator" at a server "accesses the component pool and dynamically produces a customized set of files required for the selected components and options." The server bundles up a custom installation package into one or more packages for transmission to the client. Col. 3, lines 62-67. However, Halpern does not disclose that the user selects the "customized set of files" that is bundled into one or more packages and delivered to the client. Rather, Halpern merely indicates that the user "chooses all software components and options he desires," and thus is believed to shield the user from the details of the specific files that are to be delivered to the client. See col. 3, lines 36-37. The purpose of Halpern is to avoid transmitting files to a client that are not needed to carry out the user's desires. See col. 3, lines 49-60 ("The big payoff of the invention is that extraneous program files, installation files and data files are not transmitted to the user."). Accordingly, in Halpern the

plurality of “objects” that are contained in a response message from the server are not “objects” requested from the server, as required by claim 1, since the server uses the installer set generator to produce the customized set of files that are transmitted to the client.

Claim 3:

Claim 3 requires that the “decompression of the plurality of unpacked objects is performed automatically in response to receiving the response message.” Even if all the elements of claim 1 are deemed to be met by Halpern, Halpern does not disclose automatically decompressing objects in response to receiving a response message, as required by claim 3. Halpern merely discloses a user executing a startup.exe or install.exe file and a batch mode installer application, as discussed above, that installs applications, but is silent with respect to automatically decompressing objects in response to receiving the response message. Accordingly, Halpern does not disclose all the limitations of claim 3 in as complete detail as set forth in the claim. See MPEP §2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (“The identical invention must be shown in as complete detail as is contained in the ... claim.”).

2. Claims 4-5 and 16-17

Claims 4-5 and 16-17 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Halpern. Among these claims, claims 4 and 5 depend from claim 1 and claims 16 and 17 depend from claim 13.

Claim 4, for example, is directed to “packing a plurality of requests for the plurality of objects in a packed request message and transmitting the packed request message to the server.” In the Examiner’s Answer the Examiner supports this rejection merely by citing to Halpern’s discussion at col. 4, lines 5-10 about a “packetization transport protocol” which relates to communication from the server to the client. The Examiner then asserts, baldly, that “[i]f this packetization transport protocol is used in one direction it obviously would be used in the other direction.” See Ex. Ans. at p. 19. Halpern neither teaches nor suggests packing a plurality of requests in a message and transmitting that message to the server. The portions of Halpern the Examiner relies upon relate only to communications from a server to a client and provide no teaching or suggestion to pack a plurality of requests in a message sent from the client to the server.

3. Claims 6-7, 18-19 and 27

Claims 6-7, 18-19 and 27 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Halpern in view of Feinman. Among these claims, claims 6 and 7 depend either directly or indirectly from claim 1, claims 18 and 19 depend either directly or indirectly from claim 13, and claim 27 depends from claim 25.

Claim 6 depends from claim 1 and further comprises “outputting the plurality of unpacked objects in an order indicated in the response message.” The claim is rejected as being obvious in view of Halpern and Feinman. In rejecting this claim the Examiner admits that Halpern does not teach the limitations of claim 6 and relies on Feinman’s disclosures at col. 2, lines 34-35 and col. 3, line 43 through col. 4, line 12 for allegedly disclosing outputting

applications having a certain order indicated by a server. The Examiner asserts that it would have been obvious to have modified Halpern in view of Feinman to include ordering of objects to allow a server to dictate the order in which objects must be presented. In the Examiner's Answer the Examiner asserts that "Feinman teaches a system for packaging up one or more applications for transfer between a server and a client (see col. 2, lines 11-45)." The Examiner relies on Feinman for disclosing that application programs are delivered with information being stored in a "sequential file." At page 21 of the Examiner's Answer the Examiner asserts that Feinman teaches at col. 3, line 12 through col. 4, line 12, packing up a list of files to be transmitted to the client in a sequential file and including a time that each program is to be delivered. The Examiner appears to take the position that Feinman, by disclosing the sequential file shown in Fig. 7, teaches the limitations of claim 6.

It is respectfully submitted that even if Halpern were modified based on Feinman, as the Examiner urges, all the limitations of claim 6 would not be met. Contrary to the Examiner's assertion, Feinman merely discloses that the sequential file shown in Fig. 7 indicates times at which an application in the sequential file is to be installed. However, Feinman does not disclose or indicate in order in which a plurality of unpacked objects are output, as required by claim 6. In fact, Feinman does not appear to disclose sending more than one application at any one time to a client. As shown in Fig. 4 of Feinman after the "time to deliver" step 18 is performed the process flows to step A shown in Fig. 5. Fig. 5 shows that when the time to deliver an application arrives, a "binary file transfer of application" is performed in step 64. Accordingly, Feinman appears merely to disclose sending individual application programs to a client at a

certain time in a sequential file as shown in Fig. 7. Even if Halpern were modified based on teachings in Feinman, all the limitations of claim 6 would not be met since neither Halpern nor Feinman, alone or in combination, teaches or suggests “outputting the plurality of unpacked objects in an order indicated in the response message.”

4. Claims 8-10, 20-23, 28-29 and 31-32

Claims 8-10, 20-23, 28-29 and 31-32 also are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Halpern in view of Feinman. Among these claims, claims 8, 20, 28 and 31 are independent claims.

Claim 8 requires the response message to include “an indicator of the order in which the packed objects are to be presented.” As with claim 6 discussed above, neither Halpern nor Feinman, alone or in combination, teaches or suggests a response message that contains an indication of the order of the objects packed in the response message. The Examiner’s reliance on Halpern’s disclosure of a “sequential file” does not relate to an order of presentation. Whether there is some “inherent order” to any list, as asserted at page 22 of the Examiner’s Answer, is immaterial since Halpern does not suggest any order of presentation. The Examiner refers to Feinman’s discussion of compression and decompression at col. 3, lines 7-43 to somehow “show how actual presentation is accomplished.” See Ex. Ans. at p. 22. However, that portion of Feinman deals with compressing and decompressing files, but discloses nothing about presenting objects much less teaching that a response message includes “an indicator of the order in which the packed objects are presented,” as required by claim 8. Further, Halpern and Feinman are concerned with installing applications or software programs on a client, not

presenting objects. Even if Halpern's "sequential file" is deemed to teach the claimed order and Halpern's compression is deemed to equate to the claimed packing, Halpern neither teaches nor suggests an indicator of an order in which the packed objects are to be presented. Likewise, Feinman does not make up for that deficiency in Halpern. Accordingly, neither Halpern nor Feinman, alone or in combination, teach all the limitations of claim 8 and hence, do not render claim 8 unpatentable.

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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